



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
29250-002026/US

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Application Number
10/823,579Filed
April 14, 2004First Named Inventor
Dan A. BALOGH

On _____

Art Unit
2467Examiner
Hong Sol Cho

Signature _____

Typed or printed name _____

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Gary D. Yacura
Typed or printed name703-668-8000
Telephone numberJuly 19, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

958857



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Dan A. BALOGH et al.
Application No.: 10/823,579
Filed: April 14, 2004
Group: 2467
Examiner: Hong Sol Cho
For: METHOD OF TRANSFERRING CALL TRANSITION
MESSAGES BETWEEN NETWORK CONTROLLERS ON
DIFFERENT RADIO TECHNOLOGIES
Attorney Docket No.: 29250-002026/US

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Randolph Building
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Mail Stop AF

July 19, 2010

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Sir:

Further to the concurrent filing of the attached Notice of Appeal, the following remarks are submitted in connection with the above-identified patent application under the Pre-Appeal Brief Review. Claims 1-41 are pending in the present application.

For the reasons set forth below, review is requested for the rejection of the pending claims under 35 U.S.C. §103(a).

For the reasons detailed below, withdrawal of the current rejections is requested.

- I. Claims 1-18 and 41 stand rejected under 35 U.S.C. §103 as being unpatentable over Ahmavaara (US 7,359,347) in view of Lin (US 2004/0240430). This rejection is traversed.

Initially, please see Applicant's arguments traversing this rejection in the Amendment filed on March 15, 2010, pp. 11-12.

Claim 1 recites, inter alia, "sending the relay message over **a tunneling medium to the second network controller operating according to the second radio technology.**" On page 3 of the April 19, 2010 Office Action, the Examiner only uses Ahmavaara to teach these limitations.

Ahmavaara teaches if a UTRAN decides to perform an intersystem change, a radio network controller controlling the UTRAN initiates a relocation procedure by sending a relocation request message to **a mobile switching center**. The mobile switching center then sends a relocation command message to the old RNC to inform that resources for the relocation are allocated towards a new base station (Ahmavaara, col. 7, line 60 through col. 8, line 25).

Therefore, in Ahmavaara, a relocation request message is sent from a first network controller to **a mobile switching center** and not to a "**second network controller** operating according to the second radio technology" as recited in claim 1.

Also, because in Ahmavaara the mobile switching station and the mobile terminal communicate using a single technology there is no reason why the relocation request message would be sent over "**a tunneling medium**" as recited in claim 1.

Additionally, in Ahmavaara the mobile switching center receives **a relocation request message** from a first network controller and sends **a release command** to a second network controller. Thus, because the mobile switching center in Ahmavaara sends **separate and distinct messages** to the first and second network controllers, Ahmavaara can not teach "**sending the relay message** over a tunneling medium to the second network controller operating according to the second radio technology" as recited in claim 1.

Therefore, no combination of the cited art can teach "sending the relay message over a tunneling medium to the second network controller operating according to the second radio technology" as recited in claim 1.

In view of the above, Applicants submit that no combination of the cited art teaches or renders obvious all of the elements of independent claim 1 and independent claim 1 is allowable. Additionally, Applicants submit that independent claim 11 is allowable for at least somewhat similar reasons as independent claim 1 and on its own merits. Applicants further submit that dependent claims 2-10, 12-18 and 41 are allowable at least by virtue of their dependency from allowable base claims.

Therefore, Applicants respectfully request that this art grounds of rejection be withdrawn.

- II. Claims 19-40 stand rejected under 35 U.S.C. §103 as being unpatentable over Guilford (US 2002/0087674) in view of Vazvan (US 6,400,946). This rejection is traversed.

Initially, please see Applicant's arguments traversing this rejection in the Amendment filed on March 15, 2010, pp. 13-14.

Applicants submit that the combination of Guilford in view of Vazvan frustrates the purpose of Guilford.

MPEP § 2143.01(V) states "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is **no suggestion or motivation** to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" (emphasis added). "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are **not sufficient** to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." (emphasis added).

Guilford teaches a method for selecting a wireless network from a plurality of wireless networks. In Guilford, a wireless device may use a first wireless network for a first data request. Then, if a service request is received by the first network involving data communication that will demand more bandwidth, Guilford enables the service request via a second communication link with a second network that efficiently processes the communication request. Therefore, Guilford allows **service providers**

to swap the networks services of users to maximize the **service providers** bandwidth efficiency (Guilford, paras. [0044-0046].

Whereas, in Vazvan a mobile terminal selects a first mobile communication network based on certain criteria and establishes a first connection to the receiver using the first mobile communication network. Then, in Vazvan **the mobile terminal selects** a second mobile communication network based on certain criteria and establishes a second connection to the receiver **to optimize the bandwidth of the mobile terminal**.

Therefore, combining Vazvan with Guilford would frustrate the purpose of Guilford because in Vazvan **mobile terminals** perform the selecting of networks **to optimize the mobile terminals** connectivity. Whereas, in Guilford the **network service providers** transfer networks to optimize **the service providers bandwidth requirements**.

In view of the above, Applicants submit that no combination of the cited art teaches or renders obvious all of the elements of independent claim 19 and independent claim 19 is allowable. Additionally, Applicants submit that independent claim 29 is allowable for at least somewhat similar reasons as independent claim 19 and on its own merits.

Applicants further submit that dependent claims 20-28 and 30-40 are allowable at least by virtue of their dependency from allowable base claims.

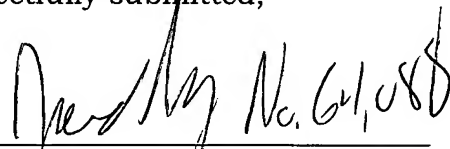
CONCLUSION

In view of the above remarks, Appellants request the Pre-Appeal Brief Conference to find in favor of Appellants' positions and arrange for withdrawal of the above-noted rejections, culminating in the sending of a Notice of Allowance of the pending claims.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-2025 for any additional fees under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

By



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